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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: WILLIAM ALLOCCA *ET AL.*

APPLICATION No.: 09/547,540

FILED: APRIL 12, 2000

FOR: **PLACING A PURCHASE ORDER USING
ONE OF MULTIPLE PROCUREMENT
OPTIONS**

EXAMINER: YOGESH C. GARG

ART UNIT: 3625

CONF. No.: 5837

REQUEST FOR REINSTATEMENT OF APPEAL

UNDER 37 C.F.R. § 1.193(b)(2)(ii)

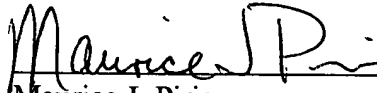
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Sir:

Applicants respectfully request reinstatement of the appeal filed on October 8, 2003. The initial appeal brief was filed on December 8, 2003. On March 2, 2004 the Examiner issued an Office Action. Applicants are submitting a Supplemental Brief along with this request.

Respectfully submitted,
Perkins Coie LLP

Date: June 2, 2004


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SUPPLEMENTAL APPEAL BRIEF¹

Sir:

Appellants are puzzled as to why the Examiner reopened prosecution. The Examiner could have withdrawn the § 112 rejection in the Answer. It appears that the Examiner has attempted to provide more persuasive arguments by citing to new portions of the Hartman reference. Appellants, however, do not understand the relevance of the newly cited portions. For example, the Examiner now states that "Hartman further teaches that a client identifier corresponds to multiple customers and these multiple customers can be identified by selecting a partially displayed purchaser-specific order information." (Office Action, March 2, 2004, p. 8). Appellants have no idea as to what point the Examiner is trying to make or what is its relevance.

Appellants would, however, like to address the Examiner's suggested motivation for combining Hartman and Yamada.

¹ This brief supplements the original brief filed on December 8, 2003. Issue C of the original brief is no longer at issue since the Examiner has withdrawn the § 112 rejection.

"Convenience" of Yamada's Predefined Delivery Address Is Not Sufficient Motivation to Combine Hartman and Yamada

The Examiner's suggested motivation for combining Hartman and Yamada is on its face insufficient to establish a *prima facie* case of obviousness. It is the Examiner's position the references can be combined

for the obvious reason that the incorporation of Yamada's feature of using multiple predefined choices for delivery information will present convenience to the buyer of having multiple predefined procurement options to be able to select for getting the ordered item delivered to either his residence, office place, a convenience store from where he can collect the item as per his convenience, as a gift to a friend's address.

(Office Action, March 2, 2004, pp. 3-4, emphasis added). Just because Yamada's predefined choices may happen to be convenient is not a sufficient motivation to combine Yamada with Hartman. Clearly, it cannot be adequate motivation to combine two reference simply because one of the references provides a "convenient" or better way of doing something. The Federal Circuit has consistently rejected similar lines of reasoning put forth by examiners. In one case, the Federal Circuit rejected the examiner's conclusory statement that a "motivation would be that the automatic demonstration mode is user friendly." *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Convenience, like user friendliness, of one aspect of a reference is not by itself sufficient motivation to combine that aspect with another reference.

Moreover, the Examiner cannot rely on identification of individual components, but rather must make "particular findings" as to the "reason" for selecting these components for combination. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). The Examiner's position that the reason for selecting Yamada's predefined delivery address is "obvious." Clearly, this is not a "particular finding" as required by law. Rather, it appears that the Examiner is relying on common sense or general knowledge, which the courts have consistently held is insufficient for establishing a motive to combine. *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001)

In addition, the "particular findings" must show "the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *In re Kotzab* at 1371 (emphasis added). The Examiner has not done so and cannot do so.

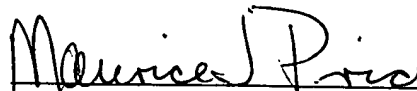
Assuming, *arguendo*, that there is a sufficient motivation to combine Hartman and Yamada, then they can be combined in several different ways to achieve the motivation that the Examiner suggests is obvious. For example, Yamada's multiple delivery addresses could be added to Hartman's shopping cart. Such a combination would allow a buyer to select different predefined delivery addresses when checking out via a shopping cart. As another example, Yamada's multiple delivery addresses could be added to Hartman's setup of a delivery location for single-action ordering. Such a combination would allow a buyer to select a predefined delivery address for use as the "default" delivery address for single-action ordering. After setting the default delivery address, the buyer could use Hartman's single-action ordering and have the ordered item sent to the default delivery address. Each of these example combinations would have the convenience of predefined choices for the selection of a delivery address.

The Examiner has not explained, however, why one skilled in the art would eschew these relatively straightforward combinations - each would provide the "convenience" that the Examiner suggests is obvious - and instead combine them to arrive at the invention "in the manner claimed." *Id.* The Examiner is clearly and impermissibly using "that what the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983). It is only Appellants' own disclosure that suggests or motivates the "combination in the manner claimed."

Accordingly, Appellants respectfully request that the Board reverse the rejection of each of the appealed claims.

Respectfully submitted,
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Date: June 2, 2004


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